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EXAMINER	
LANIER, BENJAMIN E	
ART UNIT	**PAPER NUMBER**
2132	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/521,709	TORRUBIA-SAEZ, ANDRES	
	Examiner	Art Unit	
	Benjamin E Lanier	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 March 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 27 April 2004 amends claim 1 and cancels claim 2.

Applicant's amendment has been fully considered and is entered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-51 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 14-40 of copending Application No. 09/328,737. Although the conflicting claims are not identical, they are not patentably distinct from each other because by applicant's own admission the current application and '737 application claim a single software package having both a trial version and a purchase version. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

4. Applicant's arguments filed 27 April 2004 have been fully considered but they are not persuasive. In response to Applicant's argument that the Hurley reference is concentrated on the

return aspect of the software packages and is broad in its disclosure on the purchase process, the Examiner points to the description of prior art within the Hurley reference stating that the purchase process used with the invention is not novel and taught in various prior art reference. Sited specifically are Hellman, U.S. Patent No. 4,658,093; Chernow, U.S. Patent No. 4,999,806; Holmes, U.S. Patent No. 5,287,407; and Chou, U.S. Patent No. 5,337,357. These references will be used as an aid in interpreting the Hurley reference. See Studiengesellschaft Kohle, M.B.H. v. Dart Industries, Inc., 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984), which states:

> Dart argues, contrary to well-established law, that the trial court made an error of law in holding that anticipation must be found within a single reference. It points out that other references may be used to interpret that reference and to reveal what it would have meant to one of ordinary skill at the time the invention was made. Specifically, Dart contends that Fischer, "taken with the clear and directly applicable disclosure of the Hall and Nash publications demonstrating the extent of knowledge of one skilled in the art does clearly and unambiguously indicate that a mixture of diethyl and monoethyl aluminum chlorides is formed under the Fischer reaction conditions." (Emphasis in original.)
> [1] [1] The district court correctly stated the law regarding anticipation. It is hornbook law that anticipation must be found in a single reference, device, or process. Dart's reliance on the caveat to that rule permitting the use of additional references to interpret the allegedly anticipating reference is misplaced. The trial court was not only aware of this caveat, but also applied it in a thorough and convincing manner. Dart relies on the Hall and Nash articles for a very specific teaching, not for any light they shed on what Fischer would have meant to those skilled in the art in his day. What Dart asked the trial court to do, and what it would have us do on appeal, is to combine the teachings of the references to build an anticipation. That would be contrary to settled law, and the trial court was correct in refusing to do so.
> [2] [2] Apart from this argument, Dart also relies upon the testimony of its expert, and accuses the trial court of having relied only on "certain limited, isolated, out of context and misleading testimony" to support its conclusion. It does not matter, however, that Dart on appeal may be able to reconstruct its proofs to show that another factual conclusion could have been reached. Dart must show that the conclusion which was reached was clearly erroneous. It has not done so. Our review of the testimony as cited by the trial court and the parties leads us to the conclusion that the trial court's findings on anticipation were not in error, and they are affirmed.

5. Applicant's argument that there is not teaching of the user being given selective access to the software, depending on whether or not they have made a purchase is not persuasive because

Chou discloses user computer information to get an access code (access control code) from the vendor. The vendor sends this access control code to the user after purchase, and the unencrypted installation utility uses the access code, and user computer information, to decrypt the encrypted portions of the software package (Col. 3, line 18 – Col. 4, line 12), which would also clearly meet the limitations of first and second objects wherein the first object is a full-featured version of a software product and the second object is a version of said software having less than all of the features of the full-version, an access control portion. Therefore, the unencrypted installation utility is clearly apart of the software package and an access control executable controlling access to the software by referencing the first access control code and the selected information in the computer system as claimed.

6. Applicant's argument that the Hurley reference does not disclose a notifier which the software causes to be displayed by means of the predetermined computer system, the notifier conveying information required by the user for ordering rights to predetermined usage of the software and enabling entry of first transaction information required for the purchase of the rights is not persuasive because the Chernow reference, discussed previously, discloses that before actual purchase occurs the user is displayed information on the user computer about the available software packages and features along with pricing and licensing information. The user then supplied the desired information to the central computer along with payment information (Col. 5, line 55 – Col. 6, line 65), which further meets the limitations of an executable code section, and information required by said user for purchasing rights to said software product and enabling entry of transaction information required for said purchase of said rights.

7. Applicant's argument that there is no teaching of usage authorization information in the access control portion is not persuasive because Chou discloses that use of the software program is strictly limited to users that have been authorized after a valid payment process. The authorization occurs through a process of generating usage identification information that is stored on the user PC and stored so that the user can access the software program (Col. 1, line 45 – Col. 2, line 3). This disclosure would also meet the limitation of the user being prevented from accessing and using said first object and said usage authorization information until the prospective user executed a purchase request.

8. Applicant's argument that there is no teaching of first object, second object, and usage information being macro-compressed or micro-compressed is not persuasive because Chou teaches that the software packages can be encrypted using different encryption keys and different encryption algorithms (Col. 3, lines 18-24).

9. Applicant's argument that there is no teaching of a user license agreement is not persuasive because Chernow discloses that user's are required to confirm agreement with the vendor on the user license (Col. 1, lines 33-42).

10. Applicant's argument that there is no teaching of selecting one or more use options from a listing of said use options available, said available options being those objects available free of charge or those previously purchased by said user, said listing being provided by said executable code section accessing said usage authorization information and wherein one or more of said available objects are retrieved by said executable code section and loaded into memory is not persuasive because Hurley discloses the user selecting from demo functionality and full-version functionality (Col. 4, line 51 – Col. 5, line 3).

11. Applicant's argument that the Hurley reference does not disclose the selected information characteristic of said user's computer system is transmitted to said server after said purchase request is received by said server is not persuasive because Hurley discloses that the serial number is provided to the vendor when placing an order or when returning the software object, which would be after said purchase request is received by said server.

12. Applicant's argument that the Hurley reference does not disclose the server inserting transaction information in said software product as a watermark is not persuasive because Hurley discloses that the access control code contains information to insure its validity (watermark) (Col. 4, lines 64-66) and while Hurley does not specify this information, Hellman discloses that the validation information inserted into the software before distribution is the software name, serial number, and information about the purchaser (Col. 5, lines 57-65). This information would be considered a watermark to one of ordinary skill in the art because it is validation information and it's validity could be determined visually.

13. Applicant's argument that the Drake reference only provides protection against dump attacks by using interrupts and program termination is not persuasive because the claims do not specify the type of protection required.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claims 1-23, 25-28, 28-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Hurley, U.S. patent No. 5,984,508. Referring to claims 1-4, 7-11, 13-20, 22, 23, 25, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access

control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3).

Referring to claim 5, Hurley discloses the storage device that the computer package can be stored on is a hard drive (Col. 1, lines 17-20).

Referring to claims 6, 26-28, Hurley discloses that the access control code (decryption key) unlocks products and features (decrypts) (Col. 5, lines 1-3).

Referring to claim 12, Hurley discloses that the software package can contain audio, video, and image data (Col. 1, lines 28-31).

Referring to claim 21, Hurley discloses that the software can be purchased via a credit card (Col. 1, lines 46-49).

Referring to claims 48-51, Hurley discloses that the access control code contains information to insure its validity (watermark) (Col. 4, lines 64-66).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hurley, U.S. Patent No. 5,984,508, in view of Cooper, U.S. Patent No. 5,598,470. Referring to claim 24, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the

software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3). Hurley does not disclose that the system serial number is a hard disk or storage medium serial number. Cooper discloses the software distribution system wherein the system attributes of the user's computer system are used by encrypting the software package utilizing a key based on the computer system information (Col. 7, lines 1-5). Some of the system attributes may include hard disk serial number, format of hard disk, system model number, hardware interface cards, hardware serial number, and other configuration parameters (Col. 14, lines 28-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use system attributes of the storage medium on the user's computer system for the protection of the software package in order to ensure that only the user's computer system may access the software package as taught in Cooper (Col. 2, lines 10-24).

18. Claims 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurley, U.S. Patent No. 5,984,508, in view of Cooper, U.S. Patent No. 5,598,470. Referring to claims 29-36, 38, 39, 41, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3). Hurley does not disclose the key or validation code containing a signature. Cooper discloses the decryption key having a signature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a signature in the validation code of Hurley in order for a user of the trial use computer program system of Hurley to verify that the key or validation code that they have purchased is valid and authentic.

Referring to claim 37, Hurley discloses that the software can be purchased via a credit card (Col. 1, lines 46-49).

Referring to claim 40, Cooper discloses the software distribution system wherein the system attributes of the user's computer system are used by encrypting the software package utilizing a key based on the computer system information (Col. 7, lines 1-5). Some of the system attributes may include hard disk serial number, format of hard disk, system model number, hardware interface cards, hardware serial number, and other configuration parameters (Col. 14, lines 28-34).

Referring to claims 42-44, Hurley discloses that the access control code (decryption key) unlocks products and features (decrypts) (Col. 5, lines 1-3).

19. Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurley, U.S. Patent No. 5,984,508, in view of Drake, U.S. Patent No. 6,006,328. Referring to claims 45-47, Hurley discloses a system for product return of software wherein a user may download a demonstration version of software (software package). To obtain full access to the software the user must obtain an access code (access control code) from the vendor, which unlocks the software (Abstract). The lock would meet the limitations of an access control object for preventing at least some usage of the software on a computer system without the use of a first access control code. A serial number is generated on the user's system that uniquely identifies the user's system (selected information characteristic of the predetermined computer system). This number is provided to the vendor when placing an order to purchase (requesting purchase rights, receiving selected information, obtain payment information), which meets the limitation of a notifier. An access code (access control code) is a number generated on the vendor's system

from the serial number (access control code based on the selected information). The access control code includes information on which products and features to unlock (information identifying authorized usages of the software), as well as other information to ensure its validity. The access control code is provided by the vendor to the user upon purchase of the product, and serves to unlock the products or features purchased (Col. 4, line 51 – Col. 5, line 3). Hurley does not disclose monitoring for class attacks and dump attacks. Drake discloses software security system wherein the operating system is monitored for certain modifications like pointer table modifications (Col. 6, lines 26-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made to monitor the software distribution system of Hurley for such modifications in order to detect and prevent tampering as taught in Drake (Col. 6, lines 30-31).

Conclusion

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th0 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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